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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,423	10/12/2001	Kirk Hogan	HOGAN-06650	2436
23535	7590	01/28/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliance With 37 CFR 1.192(c)</b>	<b>Application No.</b> 09/976,423	<b>Applicant(s)</b> HOGAN, KIRK	
	<b>Examiner</b> Jeanine A Goldberg	<b>Art Unit</b> 1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on January 8, 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet

Continuation of 9. Other (including any explanation in support of the above items): This communication is in response to the brief filed January 12, 2004.

The brief is deemed defective for the reasons which follow. NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)A) The brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refer to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(5). The summary of the invention is found on page 4-5 of the brief, however there is no reference to page and line numbers, as required.

B) The brief includes a statement that claims 45-68, 71 do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206 specifically provides, "Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." On pages 5-8 the brief points out that each of "the independent claims have different limitations, they do not stand or fall together. Rather they must be evaluated separately." The brief lists the limitations of the claims, but this is merely pointing out differences, not an argument as to why the claims are separately patentable. Further, there are no arguments under paragraph (c)(8) which explain why the claims of the group are separately patentable.

#### Matters which are Appealable vs Petitionable

It is noted that in MPEP 1201, "The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter." The brief contains several matters which are deemed petitionable, not appealable.

C) As provided by MPEP 1002.02(c) "Petitions and Requests Decided by the Technology Center Directors" include: (g) refusal to enter an amendment, 37 CFR 1.127, MPEP § 714.19." The brief states that "the Examiner has Improperly failed to Enter Appellan's Amendments" (see pages 12-13). The inclusion of this argument in the brief is improper. As noted in MPEP, items which are petitionable are not proper for appeal.

D) As provided in MPEP 1208, "it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was refused entry, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, he or she should file a timely petition seeking supervisory review of the non-entry." As provided by MPEP 715.09, "Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. In re Deters, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); Ex parte Hale, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations." The brief filed states that "the examiner improperly fails to consider the declaration of Dr. Morris Waxler." This is an issue considered by petition and not by appeal to the Board of Patent Appeals, as provided in MPEP 715.09. Thus, this issue is inappropriate for the brief.

E) As provided in 706.07(c), "Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c)." The brief states that the examiner "makes the following new ground of rejection: 'The components of the kit remain fully functional absent printed instructions for use. (Final Office Action July 8, 2003, page 9)." This argument is directed to the prematurity of a final rejection which is also a matter not to be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181.

Furthermore, the response made by the examiner in the Final Office Action, pointed to by the brief, does not constitute a new ground of rejection. A new grounds of rejection is a rejection based upon a new statute or a new claim added not added by amendment to a prior rejection. The examiner has not instituted any new rejections under the statute, such as 102, 103, 112 which would constitute a new ground of rejection not necessitated by amendment.


In the event that applicant resubmits a brief in response to this communication, the examiner would like to put applicant on notice that such a brief should not contain petitionable matters, as stated in the MPEP sections above. Since the applicant is now on notice of such requirements by the MPEP, any submission which does not comply with the MPEP sections above will be considered non-bona fide.

Appellant is required to comply with provisions of 37 CFR 1.192(c). To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 6:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (571)272-0507

  
Jeanine Goldberg  
**Patent Examiner**  
January 22, 2004

  
**JEFFREY FREDMAN**  
**PRIMARY EXAMINER**